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09/982,302

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Keith D. McBrayer

MCBCP0101USA

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11/13/2003

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EXAMINER

COHEN, AMY R

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,302

Applicant(s)

MCBRAYER, KEITH D.

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-13,19,26,27 and 29-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-39 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-13,19,26,27 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by McCaffery, Jr. (U. S. Patent No. 1,619,427).

McCaffery, Jr. teaches a combination layout tool (1) comprising a triangular shaped member having three side edges (4, 5, 6) that intersect at opposite ends to form three angle corners, tread and riser slots (14) in said member extending at 90° relative to one another, said tread and riser slots having inner ends terminating in a closely spaced relation from one another without intersecting one another, and outer ends terminating in a plane parallel to one of said side edges (Fig. 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palitto (U. S. Patent No. 2,593,914).

Palitto discloses a combination layout tool (7) comprising two triangular shapes wherein each triangular shape forms two 67.5° angles and one 45° angle (Fig. 2, two triangles formed along the bisecting line 9).

Palitto does not disclose a combination layout tool comprising one triangular shaped member, with a perpendicular height from one end of said 67.5° angle corners to an opposite side edge in excess of 20 inches and wherein said height is approximately 24 inches.

Regarding claim 1: Palitto discloses the claimed invention as stated above except that the layout tool comprises two triangular shaped members formed as one. It would have been obvious to one of ordinary skill in the art to modify the combination layout tool of Palitto, to break the tool along the bisecting line 9, forming two triangles, each with two 67.5° angle corners and a 45° angle corner, since Palitto discloses the desire to form angles at 67.5° and to form a bisecting line within the layout tool for bisecting the tool into two triangles, each with two 67.5° angle corners and a 45° angle corner (Col 1, lines 45-53 and Col 3, lines 10-19), and since it has been held that constructing a formerly integral structure in various element involves only routine skill in the art. See Nerwin v. Erlichman, 168 USPQ 177, 179. See also MPEP 2144.04, section V. *Making Portable, Integral, Separable, Adjustable, or Continuous*.

Regarding the height of the tool: Palitto discloses a combination layout tool where the height is approximately 3 inches. However, to choose a height of 20 inches or 24 inches, absent any criticality, is only considered to be the "optimum" value of the height of the tool, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill

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in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination tool of Palitto to enlarge it to a size of 20 inches or 24 inches so that a user would be able to use the device for measuring and marking objects which are 20 inches or 24 inches.

5. Claim 3, 5, 7-13, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright (U. S. Patent No. 5,170,568) in view of Muench (U. S. Patent No. 1,699,619).

Wright discloses a combination layout tool (1) comprising a triangular shaped member (1) having three side edges that intersect at opposite ends to form three angle corners (Fig. 2), one of said side edges extending between two of said corners having a notch (3) in said one side edge that is closer to one of said two corners than the other of said two corners, and a plurality of laterally spaced apart elongated incremental angle lines (13) in said member adjacent the side edge of said member opposite said one corner that extends in a direction in radial alignment with said notch in said one side edge (Col 3, lines 16-33).

Wright discloses the combination layout tool wherein one of the incremental angle lines is a 90° angle line in a direction perpendicular to said one side edge in alignment with said notch (Fig. 3).

Wright discloses the combination layout tool comprising a triangular shaped slot (14) in said member in close proximity to said notch having an acute angle corner (acute angle corners of slot 14 are facing the notch, Fig. 3) for latching one end of a string in said corner of said triangular shaped slot that has been pulled over said notch and one of said incremental angle lines and through said triangular shaped slot.

Wright does not disclose the combination layout tool wherein the incremental angle lines are incremental angle slots which terminate in spaced relation from the side edge opposite said one corner; comprising at least one rafter tail/ridge cut pattern formed in said one side edge in a spaced relation from said notch, said pattern comprising two straight sides intersecting said one side edge and intersecting one another at 90° , one of said sides being shorter than the other side; comprising at least two rafter tail/ridge cut patterns; wherein one of said patterns is a 4 and 12 pitch pattern, and another of said patterns is a 6 and 12 pitch pattern.

Muench discloses a combination layout tool wherein the incremental angle lines are incremental angle slots (34), which terminate in spaced relation from the side edge opposite said one corner (Fig. 4).

Muench discloses the combination layout tool wherein said incremental angle slots are spaced 5° apart (Figs. 1, 4, and 5).

Muench discloses the combination layout tool comprising at least one rafter tail/ridge cut pattern (8) formed in said one side edge (Fig. 1), said pattern comprising two straight sides intersecting said one side edge and intersecting one another at 90° (Fig. 1), one of said sides being shorter than the other side (Fig. 1); comprising at least two rafter tail/ridge cut patterns (8, 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination layout tool of Wright to replace the incremental angle lines with incremental angle slots in a spaced relation from the side edge and include rafter tail/ridge cut patterns in a side edge, as taught by Muench, so that the angles could be more precisely drawn using the slot as a mark, so that the side edge of the combination tool would remain a

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straight edge by having the slots spaced from the side edge, and placing the patterns on the edge near said notch would provide an easy and efficient way of tracing 90° angles while maintaining the straight edge of the side opposite the notch.

Regarding claims 7-9: Wright and Muench disclose a combination layout tool comprising incremental angle slots spaced 5° apart. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide additional angle slots between the 5° apart slots, i.e. at 22 ½° and 67 ½°, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made so that a user would have a more exact angle scale with which to work, and so that specific angles needed in construction would be present.

Regarding the pitch of the patterns: Wright and Muench disclose a combination layout tool where there are rafter tail/ridge cut patterns but do not specifically states a particular value for this pattern. However, to choose a 4 and 12 pitch pattern and 6 and 12 pitch pattern for the cut patterns, absent any criticality, is only considered to be the “optimum” value of the pitch of the rafter tail/ridge cut patterns, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See In re Boesch, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rafter/tail ridge cut patterns to be 4 and 12 pitch and 6 and 12

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pitch patterns since these are common patterns used in construction and therefore, would provide a fast and accurate way of tracing these patterns.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright and Muench as applied to claims 3, 5, 7-13, and 30 above, and further in view of Premo (U. S. Patent No. 2,579,857).

Wright and Muench disclose the combination layout tool as described above in paragraph 5 and comprising a pivot point receiving hole in said member adjacent one of said corners (pivot point receiving hole 13a, Fig. 1 of Muench).

Wright and Muench do not disclose a combination layout tool comprising a plurality of incrementally spaced marker receiving holes in said member in incremental spaced relation from said pivot point hole for drawing different diameter circles by rotating said tool about a pivot point extending through said pivot point hole using a marker extending through one of said marker receiving holes, said pivot point receiving hole and said marker receiving holes being in a common plane in parallel spaced relation to said one side edge.

Premo discloses a combination layout tool comprising a pivot point receiving hole (33) in said member adjacent one of said corners and a plurality of incrementally spaced marker receiving holes (22) in said member in incremental spaced relation from said pivot point hole for drawing different diameter circles by rotating said tool about a pivot point extending through said pivot point hole using a marker extending through one of said marker receiving holes, said pivot point receiving hole and said marker receiving holes being in a common plane in parallel spaced relation to said one side edge (Fig. 1).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination layout tool of Wright and Muench to add a plurality of spaced holes in a common plane, as taught by Premo, so that a user could use the combination layout tool both as a protractor for measuring angles and as a compass for drawing circles.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCaffery, Jr. McCaffery, Jr. discloses the combination layout tool as described above in paragraph 2. McCaffery, Jr. does not disclose a combination layout tool wherein the tread slot has a length of 10 inches and the rider slot has a length of 7 inches.

Regarding the lengths of the tread and riser slots: McCaffery, Jr. discloses a combination layout tool where the length of the tread and riser slots are of a certain length. However, to choose a length of 10 inches for the tread slot and 7 inches for the riser slot, absent any criticality, is only considered to be the "optimum" value of the lengths of the tread and riser slots, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tread and riser slots of McCaffery, Jr. to be of 10 inches and 7 inches, respectively, in order to provide an efficient marking system for repeatedly marking lengths of tread and risers.

Response to Arguments

8. Applicant's arguments with respect to claims 3, 7-13, 19, 26, and 27 have been considered but are moot in view of the new ground(s) of rejection.
9. Applicant's arguments filed 02 September 2003, regarding claims 1 and 2, have been fully considered but they are not persuasive.
10. In response to applicant's argument that there is no suggestion or motivation to for breaking the combination layout tool of Palitto, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, breaking the combination layout tool of Palitto on the bisecting line, already formed on the tool, is suggested by Palitto since the desire to form that line is present on the combination layout tool because it would have been obvious to one of ordinary skill in the art to modify the combination layout tool of Palitto, to break the tool along the bisecting line 9, forming two triangles, each with two 67.5° angle corners and a 45° angle corner, since Palitto discloses the desire to form angles at 67.5° and to form a bisecting line within the layout tool for bisecting the tool into two triangles, each with two 67.5° angle corners and a 45° angle corner (Col 1, lines 45-53 and Col 3, lines 10-19), and since the courts have held that constructing a formerly integral structure in various element involves only routine skill in the art. See *Nerwin v. Erlichman*, 168 USPQ 177, 179. See also MPEP 2144.04, section V. *Making Portable, Integral, Separable, Adjustable, or Continuous*.

Allowable Subject Matter

11. Claims 29, 31-39 are allowed.

Reasons for Allowance

12. The following is an examiner's statement of reasons for allowance:

Claim 29: The prior art of record does not disclose or suggest a combination layout tool comprising a triangular shaped member, having a notch in said one side edge, and a plurality of laterally spaced apart elongated incremental angle slots in said member adjacent the side edge of said member opposite said one corner that extend in a direction in radial alignment with said notch in said one side edge, wherein said member has two $67\frac{1}{2}^\circ$ corners and one 45° angle corner, in combination with the remaining limitations of the claims.

Claims 31-33: The prior art of record does not disclose or suggest a combination layout tool comprising tread and riser slots in said member extending at 90° relative to one another, said tread and riser slots having inner ends terminating in closely spaced relation from one another and outer ends terminating in a plane parallel to the one side edge in combination with the remaining limitations of the claims.

Claims 34-38: The prior art of record does not disclose or suggest a combination layout tool comprising a plurality of elongated spaced apart parallel stud layout slots in said member extending in a direction perpendicular to said one side edge in combination with the remaining limitations of the claims.

Claim 39: The prior art of record does not disclose or suggest a combination layout tool comprising a hole in said member in the same plane in which the outer ends of said tread and riser slots terminate, said hole being spaced from said outer end of said riser slot a distance corresponding to the distance between the outer ends of said tread and riser slots in combination with the remaining limitations of the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents disclose combination layout tools Gilbertson (U. S. Patent No. 2,637,110), Campbell (U. S. Patent Des. 163,850), Campbell (U. S. Patent Des. 161,570), Ford (U. S. Patent No. 1,995,204), and Shaub (U. S. Patent No. 1,751,366).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC

November 5, 2003



Diego Gutierrez
Supervisory Examiner
Tech Center 2800